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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IDENTIFICATION PAGE

Applicant: ROSENDORF, CHARLES HILLEL Atty. Docket No: 1597-1070
Serial No: 09/848,191 Examiner: HAVAN, THU THAO
Filed: 3 May 2001 Group Art Unit: 3624

For: SECURITIES ANALYSIS METHOD AND SYSTEM

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

This is an appeal from the final rejection of the Examiner mailed April 7, 2005 rejecting Claims 1, 3, 4, 7-15, 17, 20-28, 30-34 and 36-39. This Brief is accompanied by the requisite fee set forth in 37 C.F.R. § 1.17(f).

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1. REAL PARTY IN INTEREST

The real party in interest is Charles Hillel Rosendorf, the inventor named on this patent application.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the appellant or the appellant's legal representative, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

There are thirty-nine (39) Claims in the application.

Claims 1, 15, 28 and 34 are the independent Claims.

The status of the Claims as set out in Office Paper No. 20051213 (Advisory Action mailed 29 December 2005) is as follows:

Claims allowed: None.

Claims objected to: None.

Claims rejected: Claims 1, 3, 4, 7-15, 17, 20-28, 30-34, and 36-39.

Claims cancelled: 2, 5, 6, 16, 18, 19, 29, and 35.

The Claims on Appeal are: Claims 1, 3, 4, 7-15, 17, 20-28, 30-34 and 36-39.

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1 4. STATUS OF AMENDMENTS

2
3 The application was filed on 3 May 2001. There are thirty-nine (39)
4 Claims, of which four (4) are independent Claims (Claims 1, 15, 28 and 34).
5

6 A final rejection was issued in Office Paper 20050403 (mailed 7 April
7 2005). A new examiner assumed responsibility for this application after the
8 final rejection was mailed.
9

10 An amendment in response to this final rejection was filed on 7
11 September 2005, using the U.S. Postal Service. However, because Applicant's
12 representative had not received the acknowledgment postcard that was included
13 with the papers mailed on 7 Sept. 2005, and had verified with the Office that the
14 Office had no record of such a submission, a duplicate copy of the 7 Sept. 2005
15 amendment was transmitted by facsimile on 9 November 2005.
16

17 An Advisory Action (Paper No. 20051213, mailed 29 December 2005)
18 stated that the amendment filed 9 November 2005 would not be entered for purposes
19 of appeal, and the status of the claims will be:
20

21	Claims allowed:	None.
22	Claims objected to:	None.
23	Claims rejected:	Claims 1, 3, 4, 7-15, 17, 20-28,
24		30-34, and 36-39.
25	Claims cancelled:	2, 5, 6, 16, 18, 19, 29, and 35.

26

27 In the Advisory Action, the Examiner stated that the amended
28 limitations "choosing a range for data points related to a security and choosing
29 a plurality of data points related to the security from within this range" would
30 require further search and reconsideration.
31

32
33 5. SUMMARY OF CLAIMED SUBJECT MATTER
34

35 Four (4) independent Claims are involved in this appeal, Claims 1,
36 15, 28 and 34. Pursuant to 37 CFR 41.37(c)(1)(v), all references to the

1 specification refer to the specification filed 3 May 2001.

2
3 **Claim 1**
4

5 Claim 1 describes the method of securities analysis. The first step
6 in this analysis involves obtaining a set of data points related to a security,
7 where each point comprises data that regards the security. Fig. 2A summarizes
8 some of the elements of this first step, in which at 104 both historical data 212
9 and daily data 214 concerning a security are obtained from a third party, and at
10 106 this data is imported into one or databases 213, 215 and 216 maintained on
11 a computer system (shown schematically in Fig. 1). This security data can
12 include items such as symbols, dates, prices, and prices at specific dates and
13 specific times (Fig. 5, lines 13-15).
14

15 Once the data points regarding the security has been obtained,
16 the method then designates one of the data points as a reference data point. For
17 example, Fig. 3 illustrates a series of comparisons, Fig. 4 illustrates a
18 specific comparison, where the reference point is a specific day at a specific
19 time (Fig. 4, line 3) which is then compared to another day at another time (Fig.
20 4, line 4). Other examples of designating a data point as a reference point are
21 in the specification at p. 8, line 25 - p. 9, line 13 (referring to a sequential
22 comparison), p. 9, lines 15-18 (referring to a random comparison, and p. 9, lines
23 20-26 (single date comparison). Additional description of the comparison
24 function are found at p. 10, line 12 - p. 12, line 5; and some of the data
25 comparison functions employed in this method are summarized on p. 10, line 32 -
26 p. 11, line 22.
27

28 The next step of the method involves choosing one of the data points
29 as a chosen data point, wherein the chosen data point further comprises a
30 plurality of individual data points, not using an arithmetical pattern. The
31 paragraph on p. 9, lines 15-18 describes the "Random" comparison function. This
32 paragraph (p. 9, lines 15-18) specifically defines the random function "as
33 choosing dates and times without use of an arithmetical pattern between the;
34 arithmetical patterns are the approach used in the prior art". Page 9, lines 20-
35 26 describes a "Single Date Comparison Function" 270 (step 120 in Fig. 3A)
36 wherein the chosen data point can either be the date or a time. Page 11, lines

1 5-8 refers to using the Net Asset Value or Adjusted Net Asset Value as a chosen
2 data point. Additional functions described at p. 13, line 27 - p. 15, line 1
3 illustrate choosing a single date as a reference point (p. 13, lines 31-35), or
4 a specific date and time (p. 14, lines 22-25) as the reference data point.

5
6 Example 1a (p. 14, line 20 - p. 16, line 23 illustrate the last step
7 of the method, in which the data of a chosen data point is examined with respect
8 to the data of the reference data point, producing a data analysis, such as the
9 change in the performance of a hypothetical security shown in Table 1 (p. 16,
10 lines 1-8), and its decline of over 15% in a week's time period (p. 16, lines 17-
11 23). Another example of data analysis is shown in Tables 2-4 (Table 2, p. 17,
12 lines 1-8; Table 3, p. 17, lines 21-28; and Table 4, p. 18, lines 9-16).

13
14 Claim 1 is recited below.

15
16 1. A method for analyzing financial data, the method comprising
17 the steps of:

18 obtaining a plurality of data points related to a security,
19 each data point comprises associated data regarding the security;
20 designating one of the data points as a reference data point;
21 choosing one of the data points as a chosen data point,
22 wherein the chosen data point further comprises a plurality of
23 individual data points, not using an arithmetical pattern; and
24 examining the data of the chosen data point with the data of
25 the reference data point, thereby producing a data analysis.

26
27 Claim 15

28
29 Independent Claim 15 describes a system for analyzing financial data.

30
31 The elements of this system are described below.

32
33 One element is a means for obtaining a plurality of data points
34 related to a security, where each data point comprises associated data regarding
35 the security.

1 The means for obtaining the data points related to a security are
2 shown in the specification in Fig. 1A as system 10, Fig. 1B as microprocessor 14
3 and its affiliated components (page 6, line 17- p. 7, line 10); data from a third
4 party provider 40 (p. 7, lines 12-23), and loaded into the memory of the user's
5 computer system (p. 7, line 31 - p. 8, line 1).

6
7 Figure 2A summarizes some of these elements, in which at 104 data
8 points such as historical data 212 and daily data 214 concerning a security are
9 obtained from a third party (p. 7, lines 31-35), and at 106 this data is imported
10 into one or more databases 213, 215 and 216 maintained on a computer system
11 (shown schematically in Fig. 1; p. 7, line 35-p. 8, line 10). This security data
12 can include items such as symbols, dates, prices, and prices at specific dates
13 and specific times (Fig. 5, lines 13-15).

14
15 Another element is a means for designating one of the data points as
16 a reference data point. The means for designation includes a combination of the
17 mass storage device 20 (p. 6, lines 17-21) on which the computer program
18 (software 33, p. 7, lines 2-10) resides, an input means such as keyboard 26,
19 mouse 28 or a similar pointing device such as the ACCUPOINT® (Registered
20 trademark of Toshiba America Information Systems, Inc.), and a visual display
21 means 30, such as a cathode ray tube display, or its equivalent (shown in Fig.
22 1 and described on p. 6, line 32 - p. 7, line 2).

23
24 Examples of the means for choosing one of the data points as a chosen
25 data point, not using an arithmetical pattern, while encompassing the same
26 computer hardware and software elements described in the previous paragraph, also
27 includes, for example, the software for performing a random comparison (p. 9,
28 lines 15-18), the sequential comparison described on p. 8, line 25 - p. 9, line
29 13 (referring to a sequential comparison), p. 8, lines 20-26 (single date
30 comparison) and also included on p. 10, line 7 - p. 12, line 5, and particularly
31 on p. 10, line 32 - p. 11, line 22.

32
33 The means for examining the data include the combination of computer
34 hardware and software described in the paragraphs above, the video display
35 terminal, and can include printer 24 (Fig. 1), use of a table 302, spreadsheet
36 304, graph 306 (Fig. 3A, lines 20-26) or export to another system or program

(Fig. 3A, lines 27-28), and described in the specification on p. 7, lines 25-29, and p. 9, lines 20-35. Example 2 illustrates some of these examining functions, with the Table function 302 described on p. 20, line 31 - p. 21, 15, the spreadsheet function 304 on p. 21, line 18 - p. 21, line 60, and the graph function 308 on p. 22, lines 8-32.

Using one or more of these functions, the user can analyze their data, and determine whether a security has performed to the user's satisfaction, or other criteria the user has chosen (p. 2, lines 29-33, p. 27, lines 8-13, and p. 34, lines 14-17).

Claim 15 is recited below.

15. A system for analyzing financial data, the system comprising:
a means for obtaining a plurality of data points related to a security, each data point comprising associated data regarding the security;
a means for designating one of the data points as a reference data point;
a means for choosing one of the data points as a chosen data point, wherein the chosen data point further comprises a plurality of chosen data points, not using an arithmetical pattern;
a means for examining the data corresponding to the reference data point with the data corresponding to the chosen data point, thereby producing a data analysis.

Claim 28

Claim 28 is a method for analyzing data of a category. In contrast to Claim 1, which is a method of securities analysis, Claim 28 analyzes data of a category. The paragraph on p. 12, lines 7-16 describes a plurality of categories in which this method can be utilized. In addition to stock market equities, other categories include indices, sales, government and/or corporate budgets, inventories, environmental monitoring, process monitoring, margin data, depreciation data, and amortization data are among the categories in which the claimed method can be employed. This paragraph (p. 12, lines 7-16) also

1 indicates that non-financial comparisons can be performed utilizing the claimed
2 method.

3
4 The first step in this analysis involves obtaining a set of data
5 points related to the category, where each point comprises data that regards the
6 category. The examples that were provided utilized a security as the category,
7 but as defined in the specification (p. 12, lines 7-16), the claimed invention
8 is not intended to be so limited. Thus, Fig. 2A summarizes some of the elements
9 of this first step, in which at 104 both historical data 212 and daily data 214
10 concerning a category (in this instance, a security) are obtained from a third
11 party, and at 106 this data is imported into one or databases 213, 215 and 216
12 maintained on a computer system (shown schematically in Fig. 1). This category
13 data can include items such as symbols, dates, prices, and prices of a category
14 such as a security, at specific dates and specific times (Fig. 5, lines 13-15).
15

16 Once the data points regarding the category have been obtained, the
17 claimed method then designates one of the data points as a reference data point.
18 For example, Fig. 3 illustrates a series of comparisons, Fig. 4 illustrates a
19 specific comparison, where the reference point is a specific day at a specific
20 time (Fig. 4, line 3) which is then compared to another day at another time (Fig.
21 4, line 4). Other examples of designating a data point as a reference point are
22 in the specification at p. 8, line 25 - p. 9, line 13 (referring to a sequential
23 comparison), p. 9, lines 15-18 (referring to a random comparison, and p. 9, lines
24 20-26 (single date comparison). Additional description of the comparison
25 function are found on p. 10, line 12 - p. 12, line 5, and more particularly p.
26 10, line 32 - p. 11, line 22 summarize some of the data comparison functions
27 employed in this method.
28

29 The next step of the claimed method involves choosing one of the data
30 points as a chosen data point, wherein the chosen data point further comprises
31 a plurality of individual data points, not using an arithmetical pattern. The
32 paragraph on p. 10, lines 15-18 describes the "Random" comparison function. This
33 paragraph specifically defines the random function "as choosing dates and times
34 without use of an arithmetical pattern between the; arithmetical patterns are the
35 approach used in the prior art" (p. 9, lines 16-18). The paragraph on p. 9,
36 lines 20-26 describes a "Single Date Comparison Function" 270 (step 120 in Fig.

1 3A) wherein the chosen data point can either be the date or a time. Page 11,
2 lines 3-8 refer to using the Net Asset Value or Adjusted Net Asset Value as a
3 chosen data point. Additional functions described on p. 13, line 27 - p. 16,
4 line 23 illustrate choosing a single date as a reference point (page 13, lines
5 27-35), or a specific date and time (p. 14, lines 20-25) as the reference data
6 point.

7
8 Example 1a1 and Table 1, and the specification from p. 14, line 20 -
9 p. 16, line 233 illustrate the last step of the claimed method, in which the data
10 of a chosen data point is examined with respect to the data of the reference data
11 point, and producing a data analysis, such as the change in the performance of
12 hypothetical security shown in Table 1, and its decline of over 15% in a one week
13 time period (p. 16, lines 17-23). Another example of data analysis is shown in
14 Tables 2-4, and in Examples 1a3 and 1a4 (p. 17, line 10 - p. 18, line 20).

15
16 Claim 28 is recited below. Please note the typographical error in
17 line 1 of this claim; the word "system" should read "method", because the steps
18 of this claim clearly recite method steps.

19
20 28. A method for analyzing data of a category, the system
21 comprising the steps of:

22 obtaining a plurality of data points related to the category,
23 each data point comprises associated data regarding the category;
24 designating one of the data points as a reference data point;
25 choosing one of the data points as a chosen data point,
26 wherein the chosen data point further comprises a plurality of
27 chosen data points, not using an arithmetical pattern;
28 examining the data corresponding to the reference data point
29 with the data corresponding to the chosen data point, thereby
30 producing a data analysis.

31
32 **Claim 34**

33
34 Claim 34 is a system for analyzing data of a category. In contrast
35 to Claim 15, which is a system for analyzing financial data, Claim 34 analyzes
36 data of a category. The paragraph on p. 12, lines 7-16 describes a plurality of

1 categories utilized by this system. In addition to stock market equities, other
2 categories include indices, sales, government and/or corporate budgets,
3 inventories, environmental monitoring, process monitoring, margin data,
4 depreciation data, and amortization data are among the categories that the
5 claimed system can utilize. This same paragraph (p. 12, lines 7-16) also
6 indicates that non-financial comparisons can be performed by the claimed system.
7

8 The elements of this system include a means for obtaining a plurality
9 of data points related to the category, where each data point comprises
10 associated data regarding the category.
11

12 The means for obtaining the data points related to the category are
13 shown in the specification in Fig. 1A as system 10, Fig. 1B as microprocessor 14
14 and its affiliated components (p. 6, line 17 - p. 7, line 10); data from a third
15 party provider 40 (p. 7, lines 12-23), and loaded into the memory of the user's
16 computer system (p. 7, line 31 - p. 8, line 6).
17

18 Figure 2A summarizes some of these elements, in which at 104 data
19 points such as historical data 212 and daily data 214 concerning a category, such
20 as, for example, a security, are obtained from a third party, and at 106 this
21 data is imported into one or databases 213, 215 and 216 maintained on a computer
22 system (shown schematically in Fig. 1). This category data can include items
23 such as symbols, dates, prices, and prices at specific dates and specific times
24 (Fig. 5, lines 13-15; specification on p. 8, lines 6-15).
25

26 The examples provided in the specification utilized a security as the
27 category, but as defined in the specification at p. 12, lines 7-16, and in the
28 subject claim, claim 28, the claimed invention is not intended to be so limited.
29 Figure 2A summarizes some of the elements of this first step, in which at 104
30 both historical data 212 and daily data 214 concerning a category (in this
31 instance, a security) are obtained from a third party, and at 106 this data is
32 imported into one or databases 213, 215 and 216 maintained on a computer system
33 (shown schematically in Fig. 1). This category data can include items such as
34 symbols, dates, prices, and prices of a category such as a security, at specific
35 dates and specific times (Fig. 5, lines 13-15).
36

1 Another element of Claim 34 is a means for designating one of the
2 data points as a reference data point. The means for designation includes a
3 combination of the mass storage device 20 (p. 6, lines 17-21) on which the
4 computer program (software 33, p.6 line 32 - p. 7, line 10) resides, an input
5 means such as a keyboard 26, mouse 28 or a similar pointing device such as the
6 ACCUPOINT® (Registered trademark of Toshiba America Information Systems, Inc.),
7 and a visual display means 30, such as a cathode ray tube display or their
8 equivalent, (shown in Fig. 1 and described on p. 6, line 36 - p. 7, line 10).
9

10 Examples of the means for choosing one of the data points as a chosen
11 data point, not using an arithmetical pattern, while encompassing the same
12 computer hardware and software elements described in the previous paragraph, also
13 includes, for example, the software for performing a random comparison (p. 9,
14 lines 15-18), the sequential comparison described on p. 8, line 25 - p. 9, line
15 13 (referring to a sequential comparison), p. 9, lines 20-26 (single date
16 comparison) and also included in p. 10, line 12- p. 12, line 5, and more
17 specifically on p. 10, line 32 - p. 11, line 22.
18

19 The means for examining the data include the combination of computer
20 hardware and software described in the paragraphs above, the video display
21 terminal, and can include printer 24 (Fig. 1), use of a table 302, spreadsheet
22 304, graph 306 (Fig. 3A, lines 20-26) or export to another system or program
23 (Fig. 3A, lines 27-28), and described on p. 7, lines 25-29, and p. 9, line 20 -
24 p. 10, line 5. Example 2 illustrates some of these examining functions, with the
25 Table function 302 described on p. 20, line 31 - p. 21, line 15, the spreadsheet
26 function 304 on p. 21, line 18 - p. 22, line 6, and the graph function 308
27 (Example 2c) on p. 22, lines 8-32.
28

29 Using one or more of these functions, the user can analyze their
30 data, and determine whether, for example, a member of the category, such as a
31 security, has performed to the user's satisfaction, or other criteria the user
32 has chosen.
33

34 Claim 34 is recited below.
35

36 34. A system for analyzing data of a category, the system

1 comprising:

2 a means for obtaining a plurality of data points related to
3 the category, each data point comprises associated data regarding
4 the category;

5 a means for designating one of the data points as a reference
6 data point;

7 a means for choosing one of the data points as a chosen data
8 point, wherein the chosen data point further comprises a plurality
9 of chosen data points, not using an arithmetical pattern;

10 a means for examining the data corresponding to the reference
11 data point with the data corresponding to the chosen data point,
12 thereby producing a data analysis.

1 6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

2
3 Claims 1, 3, 4, 7-15, 17, 20-28, 30-34, and 36-39 stand rejected
4 under 35 U.S.C. 103(a) as being unpatentable over Philips et al. (U.S. Pat. No.
5 6,792,399, "the '399 patent"), and official notice.

6
7 Claims 1-39 were initially rejected under 35 U.S.C. §103(a) as being
8 unpatentable over Philips et al. (U.S. Pat. No. 6,792,399) and official notice.

9
10 The rejections of these Claims could be grouped as follows:

11
12 Whether Claims 1, 14, 15, 26-28, 32-34, and 38-39 are unpatentable
13 under 35 U.S.C. §103(a), as being obvious based on col. 1, lines 15-48, col. 12,
14 line 54 - col. 13, line 20, Figs. 8 and 10, and Figs. 5A-5B of the '399 patent.

15
16 Whether Claims 3, 17, 30, and 36 are unpatentable under 35 U.S.C.
17 §103(a) based on the Abstract and col. 12, line 54 - col. 13, line 20 of the '399
18 patent.

19
20 Whether Claims 4, 31, and 37 are unpatentable under 35 U.S.C.
21 §103(a).

22
23 Whether Claims 7, 20, and 21 are unpatentable under 35 U.S.C. §103(a)
24 based on official notice.

25
26 Whether Claims 8, 10-11, and 23-24 are unpatentable under 35 U.S.C.
27 §103(a) based on official notice.

28
29 Whether Claims 9 and 22 are unpatentable under 35 U.S.C. §103(a)
30 based on the Abstract and col. 12, line 54 - col. 13, line 20 of the '399 patent.

31
32 Whether Claims 12, 13, and 25 are unpatentable under 35 U.S.C.
33 §103(a) based on Figs. 6-10 of the '399 patent.

1 7. ARGUMENT

2
3 Rejection of Claims under 35 U.S.C. § 1034
5 Introduction.

6
7 Perhaps the greatest difficulty that faced Applicant in responding
8 to the rejections in the Office Actions was Applicant's inability to understand
9 the rejections. The original Examiner, who issued rejections in both the
10 original and final Office Actions, used an approach in both Office Actions by
11 which each of Applicant's claims was quoted, followed by a short phrase (rarely
12 more than five words) which constituted the **entire explanation** of the rejection
13 of the corresponding claim. These extremely terse rejections were unclear and
14 ambiguous. Thus, Applicant was forced to speculate as to the true basis of the
15 rejections of his claims.

16
17 The unfairness of unclear and ambiguous rejections has been addressed
18 by this Board and the courts previously. A representative case is In re Herrick,
19 344 F.2d 713, 145 U.S.P.Q. 400 (C.C.P.A. 1965). In Herrick, the actual number
20 of rejections given by the examiner were so numerous that the C.C.P.A. could not
21 get a grasp on the essence of the rejection:

22
23 We decline to substitute speculation as to the rejection
24 for the greater certainty which should come from the
25 Patent Office in a more definite statement of the
26 grounds of rejections.... If ... all or most of the
27 references are really necessary to meet the claims, the
28 rejection can be made specific as to particular
29 references. (Herrick, 145 U.S.P.Q. at 401.)

30
31 Further, as in this application, in Ex parte Gambogi, 62 U.S.P.Q.2d 1209 (Bd.
32 Pat. App. and Inter. 2001) (unpublished opinion) (copy attached), this Board
33 dealt with "the vague rejections made in the final rejection" (Gambogi, 62
34 U.S.P.Q.2d at 1211). The Gambogi panel also would not speculate on the nature
35 of the rejections: "What the CCPA said in Herrick applies to this case." Gambogi,
36 62 U.S.P.Q.2d at 1212. The Board did not accept the final rejection. Gambogi,

1 62 U.S.P.Q.2d at 1213. Thus, Applicant respectfully urges the Board to reverse
2 the rejection in this application.

3
4 Regardless, for purposes of this appeal, the following Argument is
5 based upon Applicant's speculation as to the basis of the rejections of his
6 claims.

7
8 A. Whether Claims 1, 14, 15, 26-28, 32-34, and 38-39 are
9 unpatentable under 35 U.S.C. §103 over Phillips et al. (U.S.
10 Pat. No. 6,792,399).

11
12 Claims 1, 14, 15, 26-28, 32-34, and 38-39 were rejected under 35
13 U.S.C. §103(a) as being unpatentable over Phillips et al. U.S. Pat. No. 6,792,399
14 ("the '399 patent").

15
16 The text of 35 U.S.C. §103(a) is reproduced below for reasons which
17 will become apparent in this section of the Argument.

18
19 (A) A patent may not be obtained though the invention is
20 not identically disclosed or described as set forth in
21 section 102 of this title, if the difference between the
22 subject matter sought to be patented and the prior art
23 are such that the subject matter as a whole would have
24 been obvious at the time the invention was made to a
25 person having ordinary skill in the art to which the
26 subject matter pertains. Patentability shall not be
27 negatived by the manner in which the invention was made.

28
29 The rejection of this group of claims is based solely on the
30 examiner's rejection of Claim 1. The argument for the patentability of this
31 group of claims (Claims 1, 14, 15, 26-28, 32-34, and 38-39) is based on the
32 argument for Claim 1.

33
34 Claim 1 was rejected based on Phillips '399, the examiner rejecting
35 various claim elements and portions of claim elements based on, in order:
36

1 -column 1, lines 1-62, col. 3, lines 16-41, col. 12,
2 lines 14-48, col. 7, lines 1-14 and col. 47, lines 18-
3 65;

4
5 -abstract: cluster analysis, Figs. 8, 10; col. 1, lines
6 6-10; col. 12, lines 14-49 (derivatives as securities),
7 and col. 9, lines 12-44;

8
9 -Figures 5A, 5B; Fig. 8, and col. 121 [sic], line 7;

10
11 -Figure 5A, 5B, abstract: cluster; col. 1, lines 6-12
12 (clusterization); and

13
14 -abstract, Fig. 5A, 5B, Fig. 8, col. 12, line 94 - col.
15 13, line 20, and col. 12, lines 14-43.

16
17 Applicant had traversed these rejections, and submits that the
18 rejection of Claim 1 and this group of related claims is improper. To reject a
19 claimed invention based upon its obviousness over the prior art, the examiner
20 must support such a rejection by establishing the invention's prima facie
21 obviousness. The examiner must show where in the art cited there is a
22 description of the claimed invention sufficient to have taught or suggested the
23 invention to ordinarily skilled artisans of the time (see, e.g., ACS Hospital
24 Systems, Inc., v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (F. Cir. 1984); see
25 also, In re Fine, 5 U.S.P.Q.2d 1596 (F. Cir. 1988)).

26
27 Evaluation of whether the cited documents provide the necessary
28 description requires consideration of "(1) whether the prior art would have
29 suggested to those of ordinary skill in the art they should make the claimed
30 [invention] ... and (2) whether the prior art would have also revealed that in
31 so making ... those of ordinary skill would have a reasonable expectation of
32 success" (In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (F. Cir. 1991)). "Both the
33 suggestion and the reasonable expectation of success must be found in the prior
34 art, not in the applicant's disclosure" (In re Vaeck, supra). That is, "one
35 cannot use hindsight reconstruction to pick and choose amongst isolated
36 disclosures in the prior art to deprecate the claimed invention" (In re Fine,

1 supra at 1600).

2
3 Each claim limitation must be taught, either explicitly or implicitly
4 by the teachings of the reference. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd.
5 Pat. App. and Inter. 1985). "The examiner must make a convincing line of
6 reasoning as to why the artisan would have found the claimed invention to have
7 been obvious in light of the teachings of the references." Ex parte Clapp, 227
8 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985).

9
10 The '399 patent is entitled "Combination Forecasting Using
11 Clusterization". The section of column 1 cited by the examiner is a history of
12 forecasting contests, with the aim of predicting the future outcome of an event.
13 The col. 3 citation relates to Financial and Economic Forecasting, a general
14 section stating that "people have attempted to formulate forecasts of prices and
15 economic activity by using a variety of techniques" (col. 3, lines 34-35), but
16 this has no relevance to the claimed invention. The col. 12 citation relates to
17 a derivative instrument, a type of security, determining its' value at a future
18 date, and obtaining a number of individual forecasts on a future date. The col.
19 48 and col. 7 citations relate to cluster analysis and a contest that produces
20 forecasting data for a number of unspecified, yet predesignated variables, whose
21 values change with time, respectively, but which sections appear to have no
22 relevance to the claim element relating to obtaining a plurality of data points
23 related to a security.

24
25 Regarding the second clause and the rejection thereof of Claim 1,
26 (each data point comprises associated data regarding the security) Applicant
27 admits that Fig. 8, the citation of col. 1, lines 6-10 and col. 9 show data
28 points that comprise data associated with a security. The Abstract, however,
29 relates to predictions made by forecasters, and does not specify what data is
30 being represented by clusterization. However, the mere fact that one element of
31 a claimed invention is taught by a reference, is not, by itself, sufficient to
32 support a rejection of the entire claim. As Applicant will show further dealing
33 with the remaining rejections of Claim 1, the examiner has failed to meet the
34 burden of making a prima facie case of obviousness, and accordingly, the Board
35 must reverse the rejection of Claim 1 and the claims grouped in association
36 therewith.

1 As Applicant understands the examiner's comment in the rejection of
2 the next element of Claim 1 (designating one of the data points as a reference
3 data point, it appears this rejection is based on a statement that the '399
4 patent's reference data is the value of the underlying asset at a future date.
5 But Applicant's claimed invention is not intended for predicting values at a
6 future date; it relates to using historical data to enable the user to make
7 decisions based on past performance.

8
9 Figures 5A and B, and 8 illustrate historical data, Figs. 5A and B
10 illustrating a single parameter, and Fig. 8 illustrates several parameters
11 combined onto a single display. These figures do not show any point being
12 designated as a reference point; they merely show a series of historical
13 parameters, and providing for a means which the user can employ to enter a future
14 value for that parameter (either by clicking on a point in the future in Figs.
15 5A or 5B, or using text box 58 or 59 in those figures) has nothing to do with the
16 claimed invention's choosing a data point not using an arithmetical function.

17
18 There is no column 121 in the '399 patent. Applicant assumes, for
19 the purposes of this Argument, that the examiner was referring to col. 12, line
20 17, which merely refers to the general nature of the '399 patent's invention, and
21 its use for pricing derivative instruments.

22
23 The citations supporting the rejection of the next element of Claim
24 1 are also inappropriate (choosing one of the data points as a chosen data point,
25 wherein the chosen data point further comprises a plurality of individual data
26 points not using an arithmetical function); the rejection was based on Figs. 5A,
27 5B; Fig. 8, abstract, and col. 1, lines 6-12.

28
29 As stated previously, Figures 5A and B, and 8 illustrate historical
30 data, Figs. 5A and B illustrating a single parameter, and Fig. 8 illustrates
31 several parameters combined onto a single display. But showing a series of
32 historical parameters, and providing for a means which the user can employ to
33 enter a future value for that parameter (either by clicking on a point in the
34 future in Figs. 5A or 5B, or using text box 58 or 59 in those figures) has
35 nothing to do with the claimed invention's choosing a data point not using an
36 arithmetical function.

1 In the final rejection of Claim 1 (page 3, lines 8-9, Paper No/Mail
2 Date 20050403, mailed 7 April 2005), the examiner stated that "It is to be noted
3 that a random pattern of data points is an type of arithmetical pattern".
4

5 By this comment, the examiner has completely misconstrued this
6 element of Applicant's claimed invention, because if this reasoning is taken to
7 its logical conclusion, **any type of calculation** which involves numbers is an
8 arithmetical pattern, and therefore any calculation, even those involving
9 geometric progressions, are arithmetical. While a geometric progression may
10 involve arithmetic in the sense that one is using arithmetic to do the
11 calculations, it is still a geometric progression, not merely an arithmetical
12 pattern. The examiner's comment and assumption are obviously incorrect, and
13 completely ignore Applicant's explicit statement in the specification, that the
14 "Random" method is defined as choosing dates and times without use of an
15 arithmetical pattern between them; arithmetical patterns are the approach used
16 in the prior art (paragraph 46).
17

18 Regarding the rejection of the last element of independent Claim 1
19 (examining the data of the chosen data point with the data of the reference data
20 point, thereby producing a data analysis), which was based on the abstract, Fig.
21 5A, 5B, Fig. 8, col. 12, line 54 - col 13, line 20, and col. 12, lines 14-43, the
22 rejection is also inappropriate.
23

24 Repeating what was previously stated, Figures 5A and 5B are not a
25 data analysis that is the result of the invention, rather, they are a means for
26 making predictions in a forecasting contest, with reference numerals 58 and 59
27 illustrating text boxes through which an individual can also enter their numeric
28 prediction. The data shown in Figs. 5A and 5B is merely historical. Figure 8
29 merely illustrates a display of several historical parameters on one display.
30 The column 12 citation describes that the '399 invention is directed to
31 forecasting values, and that the model can be used to predict a variable, but
32 does not specify whether a data analysis is actually produced.
33

34 As described in the preceding paragraphs, the examiner has failed to
35 show how the subject matter of the claimed invention, taken as a whole, would
36 have been obvious to one of ordinary skill in the art at the time of the

1 invention. Much of the '399 patent is inapposite to the claimed invention,
2 because the '399 patent is concerned with predicting actual values for a future
3 event. In contrast, the present invention enables the individual to study the
4 performance of a category, such as a security, over time, and use that data to
5 make decisions about how the user will proceed. But making a decision as to how
6 to proceed is vastly different than making an actual numerical prediction of an
7 event at a specific time in the future.

8
9 Thus, even if one combines all of the rejections for Claim 1, most
10 of which are based on an impermissible dissection of the claim, rather than the
11 subject matter of the claim as a whole. the examiner has failed to establish a
12 prima facie case of obviousness that the claimed invention, as described in Claim
13 1, would, at the time of the invention, have been obvious to one of ordinary
14 skill in the art.

15
16 If an independent claim is nonobvious under 35 U.S.C. 103, then any
17 claim dependent therefrom is nonobvious. In re Fine, 5 U.S.P.Q.2d 1596 (F. Cir.
18 1988).

19
20 Therefore, the Board must reverse the rejection of Claim 1,
21 independent Claims 15, 28, and 34, and the dependent claims in this group (Claims
22 14, 26-27, 32-33, and 38-39).

23
24
25 **B. Whether Claims 3, 17, 30, and 36 are unpatentable under 35**
26 **U.S.C. §103(a) based on Phillips '399.**

27
28 Applicant reiterates the legal authorities cited in the previous
29 sections of the Argument in response to the rejection of Claims 1 and its group
30 of claims.

31
32 As stated previously, each claim limitation must be taught, either
33 explicitly or implicitly by the teachings of the reference. Ex parte Clapp, 227
34 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985). "The examiner must make a
35 convincing line of reasoning as to why the artisan would have found the claimed
36 invention to have been obvious in light of the teachings of the references." Ex

1 parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985).

2
3 The MPEP §2142 further states that "When the motivation to combine
4 the teachings of the references is not immediately apparent, it is the duty of
5 the examiner to explain why the combination of the teachings is proper, Ex parte
6 Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. and Inter. 1986).
7

8 But the examiner failed to provide a convincing line of reasoning in
9 rejecting the claim; all that was stated was see the Abstract and a section of
10 the '399 patent's specification, a section dealing with "Pricing Derivative
11 Instruments" and "Utilization of Banner Ad Click-through Information".
12

13 It is still unclear which portion of these sections are being used
14 to support the rejection, even after reviewing these sections several times,
15 because there are a number of possible explanations, but none of which are on-
16 point. Column 12, lines 15-43 of Phillips relate to determining the price of a
17 derivative instrument, but it is unclear if an ordering function is described,
18 either explicitly or implicitly therein. The section describes determining
19 different prices, the possible price on a future date, and determining a
20 probability factor, but there does not appear to be any type of ordering
21 function.
22

23 Column 13, lines 1-8 relate to grouping and categorizing
24 advertisements, but even the broad reference to using statistics for each group
25 (col. 13, line 4) is very speculative as to whether any ordering is done, let
26 alone the nature of such a purported ordering function; a similar argument can
27 be made for sorting ads into categories (col. 13, lines 12). These citations are
28 neither similar to nor suggestive of Applicant's claimed ordering function, and
29 ordering in relation to a corresponding data point.
30

31 The combinations within the cited section merely points out that data
32 can be grouped, but grouping different types of data is still insufficient to
33 teach an ordering function and the type of correspondence with the data points
34 as taught by Applicant's invention.
35

36 Accordingly, the rejection of Claims 3, 17, 30 and 36 is improper

1 under 35 U.S.C. §103(a), and the Board must therefore reverse these rejections,
2 and find that these claims define patentable subject matter.

3
4
5 C. Whether Claims 4, 31, and 37 are unpatentable under 35 U.S.C.
6 §103(a) based on Phillips '399.

7
8 Claim 4 was rejected based upon Figs. 1-10. Claims 31 and 37 were
9 rejected based upon the rejection of Claim 4.

10
11 Claims 4 and 31 refer to method steps, while Claim 37 refers to a
12 reporting means to report the data analysis produced using either the method or
13 the system components of the claimed invention.

14
15 Applicant reiterates the legal reasoning of the previous sections of
16 the Argument. The Board has stated "The examiner must make a convincing line of
17 reasoning as to why the artisan would have found the claimed invention to have
18 been obvious in light of the teachings of the references." Ex parte Clapp, 227
19 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985).

20
21 The rejections of these claims is improper, because in view of the
22 Board's opinion in Ex parte Clapp, Applicant can only speculate about the basis
23 of the examiner's rejection of these claims. Of the 10 figures cited in the
24 rejection, over half of them have nothing to do with reporting a data analysis.

25
26 Specifically, citing from the '399 patent at col. 13, line 36 - col.
27 14, line 3, referring to the figure legends:

28
29 Figure 1 illustrates the home page of a forecasting contest according
30 to a representative embodiment of the '399 patent's invention.

31
32 All Figure 1 shows is a home page, with information about a
33 forecasting contest. So while one might take a "journey through our forecast
34 community", or "login" and then "register" for the forecasting content, the
35 "Today's Feature Story" of "Blah blah blither..." is exactly that, a lot of "blah
36 blah blither" that fails to teach the reporting step of Applicant's claimed

1 invention.

2
3 Figure 2 illustrates a "Community" page of a forecasting contest
4 according to a representative embodiment of the '399 patent's invention.
5

6 But all Figure 2 shows is advertising (banner ad towards to the top
7 of the page), "Today's Featured Commentary" which could be about anything, and
8 "Soapboxes", which one can assume might be comments of participants. While Fig.
9 2 also offers some "Games" and "Education" this Figure still is silent on how to
10 report data as claimed in Applicant's claimed method and system.
11

12 Figure 3 illustrates a "Library" page of a forecasting contest
13 according to a representative embodiment of the '399 patent's invention.
14

15 Figure 3 resembles Figure 2, discussed above, but relates to articles
16 dealing with forecasting (lower left panel, under "Today's Featured Article"
17 section. As in the case of the previous two figures, Figure 3 fails to discuss
18 anything on reporting data, nor does it provide any motivation to suggest
19 Applicant's claimed method or system involving the reporting of a data analysis.
20

21 Figure 4 illustrates a web page providing a site map of a website for
22 a forecasting contest according to a representative embodiment of the '399
23 patent's invention.
24

25 Figure 4 is essentially cumulative of the information shown in
26 Figures 1-3, described above. While Figure 4 might have one element under "Home
27 32" referring to "Forecast Results", there is simply no teaching in this figure
28 to suggest either a method or system including a reporting function as described
29 in Applicant's claimed invention. Element 34 refers to what are defined as
30 second level links to primary links in the first level pages (col. 15, lines 60-
31 63); these links include links to "Suggestion Box", "My Personal Information",
32 "Recommended Books" or "Reports and Data Products", but no further information
33 about reports and data products is provided in either the figure or the text of
34 the specification. It is just too speculative to conclude that anything in
35 Figure 4 teaches one of ordinary skill in the art to devise Applicant's invention
36 as described in Claims 4, 31, and 37.

1 Figure 5A illustrates a display for graphically entering prediction
2 data for two time horizons according to a representative embodiment of the '399
3 invention.

4
5 Figure 5B illustrates a display for graphically entering prediction
6 data for a single time horizon according to a representative embodiment of the
7 '399 invention.

8
9 The '399 patent's specification, not referred to by the examiner,
10 indicates the historical information shown in Figure 5 is used by participants
11 who prefer to enter their predictions in a graphical format, rather than using
12 the numerical input feature of the '399 patent (col. 25, lines 15-17, and col.
13 24, line 57 - col. 25, line 2, regarding the "Workbench" feature). The functions
14 illustrated in Fig. 5 merely show how a user would enter their predictions into
15 a system, they are not reporting the results of a data analysis as Applicants
16 have claimed in Claims 4, 31, and 37.

17
18 Figure 6 illustrates a display for graphically entering prediction
19 data using a discrete number of prediction input buttons, according to a
20 representative embodiment of the '399 invention.

21
22 Referring to the specification, not cited by the examiner, for
23 clarification of Figure 6, at col. 27, line 39 - col. 28, line 39, it indicates
24 that Figure 6 is merely another illustration of how a user can enter their
25 predictions, in this instance using incremental values determined by one of a
26 number of buttons 84-86 programmed to provide a specific value, or can enter
27 their predicted value by means of a text box 88 (col. 27, lines 39-60).

28
29 Figure 7 illustrates a display that enables the user to enter
30 predictions for several different criteria by stacking various displays
31 simultaneously on one screen (col. 28, line 47-col. 29, line 14). But entering
32 a prediction into a system does not teach either a step of reporting the results
33 of a data analysis or a means for reporting the results of a data analysis, as
34 does Applicant's claimed invention.

35
36 Figure 8 illustrates a display of a graph that includes data curves

1 for five different prediction variables, according to a representative embodiment
2 of the '399 invention.

3
4 In contrast to Figure 7, in which the data for several parameters are
5 shown on separate screens within a larger overall display, Figure 8 merely
6 overlays such multiple screens, within a single display (col. 29, lines 15-32).
7 Thus, historical data are shown by reference numerals 121-125, while reference
8 numerals 131-135 indicate the predicted values that have been entered by the
9 user. Again, the values entered by the user are shown in Figure 8; the results
10 are not a report of a data analysis, such as claimed in the present invention.

11
12 Figure 9 illustrates the display of a graph showing an average (or
13 "central tendency") of predictions made by a group of forecasters and variance
14 around that average; Figure 10 illustrates a flow diagram showing process steps
15 for implementing a graphical display of variables. A review of the specification
16 of the '399 invention, which was not cited by the examiner, confirms that Figure
17 9 is directed solely to showing the average and variance mentioned above (col.
18 30, line 55 - col. 31, line 12), and Figure 10 is directed to a user choosing
19 which variables should be graphed per graphs of Figure 9's type (col. 32, line
20 25 - col. 33, line 58). Thus, neither Figures 9 and 10 is related to a report
21 of any data analysis, specifically the reporting disclosed by Applicant. In
22 conclusion, Figures 9 and 10 are not relevant to the present pending claims.

23
24 Parallel to the above discussion, Claim 37 includes a reporting means
25 to report the results of a data analysis, but neither Figure 9 nor 10, nor the
26 related portions of the specification (col. 30, line 55 - col. 31, line 12; and
27 col. 32, line 25 - col. 33, line 58; respectively) describe a reporting means
28 regarding data analysis.

29
30 But given the legal authority requiring the examiner to make a
31 convincing argument why the reference teaches the subject matter of the claimed
32 invention, as a whole, the examiner has failed to meet this legal burden. Given
33 the analysis Applicant has gone through in this section of the Argument should
34 be sufficient proof that the rejection of these claims was speculative, leaving
35 one to guess at the underlying rationale for the rejection of the claims. The
36 rejection was merely too speculative to enable one of ordinary skill in the art

1 to know what was being rejected and why. Accordingly, the Board must find that
2 the rejection of Claims 4, 31, and 37 was improper, reverse the rejection of
3 these claims, find that they determine patentable subject matter, and thus allow
4 these claims.

5
6
7 D. Whether Claims 7, 20, and 21 are unpatentable under 35 U.S.C.
8 §103(a) based on Phillips '399.

9
10 Claims 7, 20, and 21 were rejected under official notice in
11 combination with col. 6, lines 44-49 of the '399 patent.

12
13 While Applicant may be willing to concede that the general concept
14 of "percentage change" is known, the Board is certainly aware of the well-known
15 concept that most inventions utilize known components, but it is generally how
16 these known components are used or assembled that is the basis for the novelty
17 of most inventions. This principle was stated by Judge Learned Hand as "Almost
18 all inventions are combinations of old elements, whose selection as a new unit
19 gives them their only importance." Philip A. Hunt Co., v. Mallinckrodt Chemical
20 Works, 83 U.S.P.Q. 277, 279 (2d Cir. 1949).

21
22 The examiner has admitted in the Office Action that the Phillips '399
23 patent does fail to disclose calculation of percentage change.

24
25 While the MPEP §2144.03 states that "in limited circumstances, it is
26 appropriate for an examiner to take official notice of facts not in the record
27 or to rely on "common knowledge" in making a rejection, however, such rejections
28 should be judiciously applied."

29
30 But the C.C.P.A. held that the notice of facts beyond the record
31 which may be taken by the examiner must be "capable of such instant and
32 unquestionable demonstration as to defy dispute" in In re Ahlert, 165 U.S.P.Q.
33 418, 420 (C.C.P.A., 1970). The Federal Circuit has stated that "it is never
34 appropriate to rely solely on "common knowledge" in the art without evidentiary
35 support in the record, as the principal evidence upon which a rejection was
36 based." In re Zurko, 59 U.S.P.Q.2d 1693, 1697 (F. Cir. 2001).

1 The section of the '399 patent cited by the examiner is merely an
2 example of how the '399 patent could be used to predict trends. Line 49 cites,
3 parenthetically, that an individual may use a percentile ranking in their
4 prediction events. But there is simply no motivation in this reference that
5 would enable one of ordinary skill in the art to make the leap from "percentile
6 ranking" to a specific type of percentage change over time. One could speculate
7 in any of several different ways about how the percentile rankings referred to
8 in the reference could be developed, and all this does is illustrate further the
9 speculative nature of the examiner's rejection, and lack of motivation on the
10 part of the reference to teach Applicant's claimed method to determine the change
11 of a security, or other category, over time.
12

13 In Applicant's response to the first Office Action, Applicant
14 requested that the examiner produce authority for the rejections based on
15 official notice. The only documentary evidence produced by the examiner in
16 response was a reassertion of the examiner's previous position, and no further
17 explanation was provided. Under Zurko, 59 U.S.P.Q.2d at 1697, this action was
18 improper, and therefore not legally sufficient to maintain a rejection under 35
19 U.S.C. §103(a). MPEP §2144.03 states that if the traverse was inadequate, the
20 examiner should include an explanation why it was inadequate.
21

22 No such explanation was provided in the Office Action; merely a
23 statement that the arguments were unpersuasive.
24

25 Therefore, the Board must reverse the rejection of Claims 7, 20, and
26 21 under 35 U.S.C. §103(a) and official notice, and determine that these claims
27 define patentable subject matter.
28
29

30 **E. Whether Claims 8, 10-11, and 23-24 are unpatentable under 35**
31 **U.S.C. §103(a) based on Phillips '399.**
32

33 Claims 8, 10-11, and 23-24 were rejected under official notice.
34

35 Wherein "FROMPoint" is the reference point and "TOPoint" is each of
36 the chosen individual data points, and each ordered position corresponding to

1 "TOPoint" follows in the ordered series the ordered position corresponding to
2 "FROMPoint".
3

4 For this section, Applicant repeats the Argument and legal
5 authorities cited in the section immediately preceding this one. Applicant may
6 be willing to concede that the general concept of "percentage change" is known,
7 it is also a well-known concept that most inventions utilize known components,
8 but it is how these known components are used or assembled or the like that is
9 the basis for the novelty of most inventions. This principle was stated by Judge
10 Learned Hand as "Almost all inventions are combinations of old elements, whose
11 selection as a new unit gives them their only importance." Philip A. Hunt Co.,
12 v. Mallinckrodt Chemical Works, 83 U.S.P.Q. 277, 279 (2nd Cir, 1949).
13

14 The section of the '399 patent cited by the examiner is merely an
15 example of how the '399 patent could be used to predict trends. Line 49 cites,
16 parenthetically, that an individual may use a percentile ranking in their
17 prediction events. But there is simply no motivation in the reference that would
18 enable one of ordinary skill in the art to make the leap from "percentile
19 ranking" to a specific type of percentage change over time. One could speculate
20 in any of several different ways about how the percentile rankings referred to
21 in the reference could be developed, and all this shows is the speculative nature
22 of the examiner's rejection, and lack of motivation on the part of the reference
23 to teach Applicant's claimed method to determine the change of a security, or
24 other category, over time. The use of official notice is improper for the
25 reasons cited in the previous section (Section D) of the argument, and
26 accordingly, the Board must reverse the rejection of Claims 8, 10-11, and 23-24,
27 and determine that they define patentable subject matter.
28
29

30 **F. Whether Claims 9 and 22 are unpatentable under 35 U.S.C.**
31 **§103(a) based on Phillips '399.**
32

33 Claim 9 was rejected based on the abstract, and col. 12, line 54 -
34 col. 13, line 20, and Figs. 6-9 of the '399 patent.
35

36 Applicant repeats the legal authorities cited in prior sections

1 regarding the legal standards for an obviousness rejection, and that the examiner
2 must provide a clear line of reasoning to support such a rejection.

3
4 The initial burden is on the examiner to provide some suggestion of
5 the desirability of doing what the inventor has done. "To support the conclusion
6 that the claimed invention is obvious subject matter, either the reference must
7 explicitly or impliedly suggest the claimed invention or the examiner must make
8 a convincing line of reasoning as to why the artisan would have found the claimed
9 invention to have been obvious in light of the teachings of the references." Ex
10 parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985).

11
12 The Abstract of Applicant's invention states that "Using the present
13 invention, an individual can track a securities portfolio, monitor its
14 performance and make investment decisions based on performance".

15
16 The '399 patent is entitled "Combination Forecasting Using
17 Clusterization", and the sections of its' specification cited by the examiner
18 fail to provide any motivation to use the teachings of this reference to lead one
19 of ordinary skill in the art to Applicant's claimed invention.

20
21 The column 12-13 section cited deals with "forecasting values for a
22 variable" (col. 12, lines 54-55), "predict a future value of the variable" (col.
23 12, line 63), or predicting new housing starts (col. 12, line 65, col. 13, lines
24 6-7). The '399 patent may use historical data (col. 12, line 58-63), as does the
25 present claim, but that is where any similarity ends; the cited sections state
26 nothing about whether there is a reference point, whether the reference point
27 comprises a plurality of reference individual data points, nor whether there is
28 a correspondence between the reference points and the data points.

29
30 Using Applicant's claimed invention, an individual decides how that
31 individual will act, based upon the historical performance of the security or
32 other item being evaluated. The '399 patent is, on the other hand, predicting
33 a value of the subject, in the example of the '399 patent, a future price of a
34 derivative instrument, in the future. This is completely inapposite to the
35 present invention, and is an improper use of 35 U.S.C. §103(a), which has to lead
36 one to the claimed invention, not lead one away from the claimed invention.

1 The Abstract of the '399 patent is also inapposite, because while it
2 indicates that the data is analyzed using clusterization, this is such a vague
3 term that one can only speculate whether there is one to one correspondence
4 between a reference point and an individual data point, and this is not clarified
5 in the specification of the '399 patent. Accordingly, one is left with a
6 rejection that is, at best, speculative, and therefore an improper rejection
7 under 35 U.S.C. §103(a).

8
9 The figures cited by the examiner also fail to show this
10 correspondence between reference points and data points. Figs. 5-8 illustrate
11 historical data, in individual graphs for a specific parameter, or in multiple
12 graphs displayed on multiple screens or a single screen (Figs. 7-8).

13
14 Therefore, the rejection of Claims 9 and 22 under 35 U.S.C. §103(a)
15 is improper, and accordingly, the Board must reverse the examiner's rejection of
16 Claims 9 and 22.

17
18
19 **G. Whether Claims 12, 13, and 25 are unpatentable under 35 U.S.C.**
20 **§103(a) based on Phillips '399.**

21
22 Claims 12 and 13 were rejected based upon Figures 6-10. Claim 25 was
23 rejected based upon the rejection of Claim 12.

24
25 Applicant reiterates the legal authorities cited in the previous
26 sections of the Argument in response to the rejection of the Claims previously
27 argued.

28
29 Applicant also reiterates portions of the Argument for Claims 4, 31,
30 and 37 insofar as it relates to Figures 6-10 of the Phillips '399 patent.
31 Certain sections of that Argument, however, will be repeated here for the
32 convenience of the Board.

33
34 As stated previously, each claim limitation must be taught, either
35 explicitly or implicitly by the teachings of the reference. Ex parte Clapp, 227
36 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985). "The examiner must make a

1 convincing line of reasoning as to why the artisan would have found the claimed
2 invention to have been obvious in light of the teachings of the references." Ex
3 parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. and Inter. 1985).
4

5 The MPEP §2142 further states that "When the motivation to combine
6 the teachings of the references is not immediately apparent, it is the duty of
7 the examiner to explain why the combination of the teachings is proper, Ex parte
8 Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. and Inter. 1986).
9

10 Claims 12 and 13 refer to method steps. Claim 25 further defines the
11 ordering function initially described Claim 17 as an element of the examining
12 means, which examining means was initially described in independent Claim 15.
13 In Claims 12 and 25, the ordering function utilizes both the date and time order
14 for ordering the data points, by date (Claim 12) and date and time (Claim 13).
15 Claim 25 only utilizes the date function to order the data. The comparison
16 function, described in Applicant's specification from p. 13, line 27 - p. 20,
17 line 29, describe several examples of different ways of ordering the compared
18 data. The table function (p. 20, line 31 - p. 21, line 15), spreadsheet function
19 (p. 21, line 18- p. 22, line 6), or graph function (p. 22, lines 8-32) are
20 further examples of these claim elements.
21

22 Figure 6 of the Phillips patent illustrates a display for graphically
23 entering prediction data using a discrete number of prediction input buttons,
24 according to a representative embodiment of the '399 invention.
25

26 Referring to the '399 patent's specification, not cited by the
27 examiner, for clarification of Figure 6, col. 27, line 39 - col. 28, line 39,
28 indicates that Figure 6 is merely another illustration of how a user can enter
29 their predictions, in this instance using incremental values determined by one
30 of a number of buttons 84-86 programmed to provide a specific value, or can enter
31 their predicted value by means of a text box 88 (col. 27, lines 39-60). While
32 Fig. 6 may show dates, as historical data, the figure fails to illustrate
33 anything that is the product of a data analysis.
34

35 Figure 7 of the '399 patent illustrates a display that enables the
36 user to enter predictions for several different criteria by stacking various

1 displays simultaneously on one screen (col. 28, line 47-col. 29, line 14). But
2 entering a prediction into a system does not teach either an ordering function
3 of date order, resulting from a data analysis, or an ordering function comprising
4 date-and-time order, as the result of a data analysis, as does Applicant's
5 claimed invention.

6
7 Figure 8 illustrates a display of a graph that includes data curves
8 for five different prediction variables, according to a representative embodiment
9 of the '399 invention.

10
11 In contrast to Figure 7, in which the data for several parameters are
12 shown on separate screens within a larger overall display, Figure 8 merely
13 overlays such multiple screens, within a single display ('399 patent, col. 29,
14 lines 15-32). Thus, historical data are shown by reference numerals 121-125,
15 while reference numerals 131-135 indicate the predicted values that have been
16 entered by the user. Again, the values entered by the user are shown in Figure
17 8; the results are not a report of a data analysis, such as claimed in the
18 present invention.

19
20 Figure 9 illustrates the display of a graph showing an average (or
21 "central tendency") of predictions made by a group of forecasters, and variance
22 around that average; Figure 10 illustrates a flow diagram showing process steps
23 for implementing a graphical display of variables.

24
25 But Figures 9-10 could be applicable to almost any kind of data
26 analysis, but without reviewing the specification, which was not referred to at
27 all by the examiner in the rejection of these Claims, one of ordinary skill in
28 the art would truly have no idea what the examiner's rejection was based on. A
29 review of the relevant sections of the specification, confirms that Figure 9 is
30 directed solely to showing the average and variance mentioned above ('399 patent
31 at col. 30, line 55 - col. 31, line 12). Figure 10 is directed to a user
32 choosing which variables should be graphed per graphs of Fig. 9's type ('399
33 patent at col. 32, line 25 - col. 33, line 58). Thus, neither Fig. 9 or 10 is
34 related to the ordering of any data analysis, specifically the ordering disclosed
35 in Applicant's Claims 12, 13, and 25. Figures 9 and 10 therefore are not
36 relevant to the present pending claims.

1 Thus, given the legal authority requiring the examiner to make a
2 convincing argument why the reference teaches the subject matter of the claimed
3 invention, as a whole, the examiner has failed to meet this legal burden. Given
4 the analysis Applicant has gone through in this section of the Argument should
5 be sufficient proof that the rejection of these claims was speculative, leaving
6 one to guess at the underlying rationale for the rejection of the claims. The
7 rejection was merely too speculative to enable one of ordinary skill in the art
8 to know what was being rejected and why. Accordingly, the Board must find that
9 the rejection of Claims 12, 13 and 25 was improper, reverse the rejection of
10 these claims, find that they determine patentable subject matter, and thus allow
11 these claims.
12

8. CONCLUSION

Applicant respectfully submits that Claims 1, 3, 4, 7-15, 20-28, 30-34, and 36-39 define patentable subject matter, and the Board is hereby requested to reverse the rejections of these Claims, determine that these Claims define patentable subject matter, and allow the present pending Claims.

Respectfully submitted,



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1 9. CLAIMS APPENDIX

2
3 Claims involved in this appeal are:

4
5 CLAIMS.

6
7 I claim:

8
9 1. A method for analyzing financial data, the method comprising
10 the steps of:

11 obtaining a plurality of data points related to a security,
12 each data point comprises associated data regarding the security;
13 designating one of the data points as a reference data point;
14 choosing one of the data points as a chosen data point,
15 wherein the chosen data point further comprises a plurality of
16 individual data points, not using an arithmetical pattern; and
17 examining the data of the chosen data point with the data of
18 the reference data point, thereby producing a data analysis.

19
20 2. (Cancelled)

21
22 3. The method as described in claim 1, further comprising the step
23 of ordering the chosen individual data points according to an ordering function
24 prior to the examining step, thereby producing an ordered series and an ordered
25 position corresponding to each chosen individual data point.

26
27 4. The method as described in claim 3, further comprising the step
28 of reporting the data analysis.

29
30 5. (Cancelled)

31
32 6. (Cancelled)

33
34 7. The method as described in claim 3, wherein the examining step
35 comprises utilizing a comparison expressed by the equation
36

1
$$((\text{TOPoint}-\text{FROMPoint})/\text{FROMPoint})*100 = +/- \%,$$

2
3 wherein "FROMPoint" is the reference point and "TOPoint" is each of the chosen
4 individual data points, and each ordered position corresponding to TOPoint
5 follows in the ordered series the ordered position corresponding to FROMPoint.
6

7 8. The method as described in claim 3, wherein the examining step
8 comprises utilizing a comparison expressed by the equation
9

10
$$((\text{TOPoint}-\text{FROMPoint})/\text{FROMPoint})*100 = +/- \%,$$

11
12 wherein "TOPoint" is the reference point and "FROMPoint" is each of the chosen
13 individual data points, and each ordered position corresponding to TOPoint
14 follows in the ordered series the ordered position corresponding to FROMPoint.
15

16 9. The method as described in claim 3, wherein the reference point
17 further comprises a plurality of reference individual data points, there being
18 a one-to-one correspondence between the reference individual data points and the
19 chosen individual data points.
20

21 10. The method as described in claim 9, wherein the examining step
22 comprises utilizing a comparison expressed by the equation
23

24
$$((\text{TOPoint}-\text{FROMPoint})/\text{FROMPoint})*100 = +/- \%,$$

25
26 wherein each pair of "FROMPoint" and "TOPoint" are each corresponding reference
27 individual data point and chosen individual data point.
28

29 11. The method as described in claim 9, wherein the examining step
30 comprises utilizing a comparison expressed by the equation
31

32
$$((\text{FROMPoint}-\text{TOPoint})/\text{TOPoint})*100 = +/- \%,$$

33
34 wherein each pair of "TOPoint" and "FROMPoint" are each corresponding reference
35 individual data point and chosen individual data point.
36

12. The method as described in claim 3, wherein the ordering function comprises date order and each data point comprises the value of the security at a specific date.

13. The method as described in claim 3, wherein the ordering function comprises date-and-time order and each data point comprises a value of the security at a specific date and time.

14. The method as described in claim 3, further comprising the step of exporting the data analysis to a second method of analyzing financial data.

15. A system for analyzing financial data, the system comprising:
a means for obtaining a plurality of data points related to a security, each data point comprising associated data regarding the security;

a means for designating one of the data points as a reference data point;

a means for choosing one of the data points as a chosen data point, wherein the chosen data point further comprises a plurality of chosen data points, not using an arithmetical pattern;

a means for examining the data corresponding to the reference data point with the data corresponding to the chosen data point, thereby producing a data analysis.

16. (Cancelled)

17. The system as described in claim 15, wherein the examining means comprises a means for ordering the chosen data points according to an ordering function, thereby producing an ordered series and an ordered position corresponding to each chosen individual data point.

18. (Cancelled)

19. (Cancelled)

20. The system as described in claim 17, wherein the examining

1 means further comprises a means for performing a comparison expressed by the
2 equation

$$3 \quad ((\text{TOPoint} - \text{FROMPoint}) / \text{FROMPoint}) * 100 = +/- \%,$$

5
6 wherein "FROMPoint" is the reference point and "TOPoint" is each of the chosen
7 individual data points, and each ordered position corresponding to TOPoint
8 follows in the ordered series the ordered position corresponding to FROMPoint.

9
10 21. The system as described in claim 17, wherein the examining
11 means further comprises a means for performing a comparison expressed by the
12 equation

$$13 \quad ((\text{TOPoint} - \text{FROMPoint}) / \text{FROMPoint}) * 100 = +/- \%,$$

15
16 wherein "TOPoint" is the reference point and "FROMPoint" is each of the chosen
17 individual data points, and each ordered position corresponding to TOPoint
18 follows in the ordered series the ordered position corresponding to FROMPoint.

19
20 22. The system as described in claim 17, wherein the reference
21 point further comprises a plurality of reference individual data points, there
22 being a one-to-one correspondence between the reference individual data points
23 and the chosen individual data points.

24
25 23. The system as described in claim 22, wherein the examining
26 means further comprises a means for performing a comparison expressed by the
27 equation

$$28 \quad ((\text{TOPoint} - \text{FROMPoint}) / \text{FROMPoint}) * 100 = +/- \%,$$

30
31 wherein each pair of "FROMPoint" and "TOPoint" are each corresponding reference
32 individual data point and chosen individual data point.

33
34 24. The system as described in claim 22, wherein the examining
35 means further comprises a means for performing a comparison expressed by the
36 equation

1 $((\text{FROMPoint} - \text{TOPoint}) / \text{TOPoint}) * 100 = +/- \%$,

2
3 wherein each pair of "TOPoint" and "FROMPoint" are each corresponding reference
4 individual data point and chosen individual data point.
5

6 25. The system as described in claim 17, wherein the ordering
7 function comprises date order and each data point comprises a value of the
8 security on a specific date.
9

10 26. The system as described in claim 17, wherein the ordering
11 function comprises date-and-time order and each data point comprises a value of
12 the security at a specific date and time.
13

14 27. The system as described in claim 17, further comprising a means
15 for exporting the data analysis to a second means of analyzing financial data.
16

17 28. A method for analyzing data of a category, the system
18 comprising the steps of:

19 obtaining a plurality of data points related to the category,
20 each data point comprises associated data regarding the category;
21 designating one of the data points as a reference data point;
22 choosing one of the data points as a chosen data point,
23 wherein the chosen data point further comprises a plurality of
24 chosen data points, not using an arithmetical pattern;
25 examining the data corresponding to the reference data point
26 with the data corresponding to the chosen data point, thereby
27 producing a data analysis.
28

29 29. (Cancelled)
30

31 30. The method as described in claim 28, further comprising the
32 step of ordering the chosen data points prior to the examining step.
33

34 31. The method as described in claim 30, further comprising the
35 step of reporting the data analysis.
36

1 32. The method as described in claim 30, wherein the category
2 comprises finance.

3
4 33. The method as described in claim 32, wherein the associated
5 data is chosen from the group consisting of sales data, inventory data, cost
6 data, margin data, income tax data, depreciation data, and amortization data.

7
8 34. A system for analyzing data of a category, the system
9 comprising:

10 a means for obtaining a plurality of data points related to
11 the category, each data point comprises associated data regarding
12 the category;

13 a means for designating one of the data points as a reference
14 data point;

15 a means for choosing one of the data points as a chosen data
16 point, wherein the chosen data point further comprises a plurality
17 of chosen data points, not using an arithmetical pattern;

18 a means for examining the data corresponding to the reference
19 data point with the data corresponding to the chosen data point,
20 thereby producing a data analysis.

21
22 35. (Cancelled)

23
24 36. The system as described in claim 34, wherein the examining
25 means comprises a means for ordering the chosen data points prior to examining
26 the data.

27
28 37. The system as described in claim 36, further comprising a
29 reporting means to report the data analysis.

30
31 38. The system as described in claim 34, wherein the category
32 comprises finance.

33
34 39. The system as described in claim 38, wherein the associated
35 data is chosen from the group consisting of sales data, inventory data, cost
36 data, margin data, income tax data, depreciation data, and amortization data.

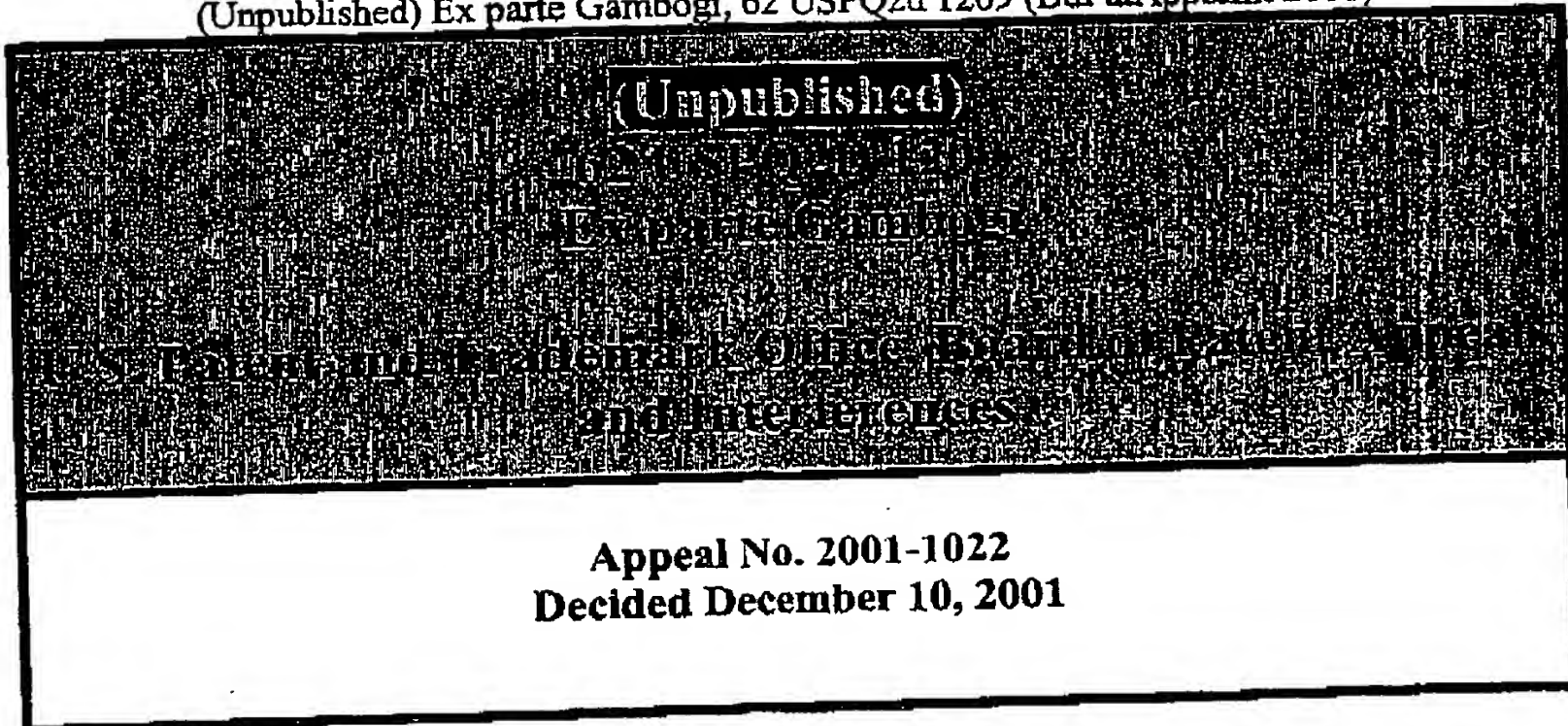
1 10. EVIDENCE APPENDIX

2

3 A. Ex parte Gambogi, 62 U.S.P.Q.2d 1209 (Bd. Pat. App. and Inter.
4 2001) (unpublished opinion)

Full Text of Cases (USPQ2d)

(Unpublished) Ex parte Gambogi, 62 USPQ2d 1209 (BdPatApp&Int 2001)



Unpublished Opinion

(Non-precedential)

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Headnotes

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Rules

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and rules practice (§110.1105)**Patentability/Validity — Obviousness — Relevant prior art — In general (§115.0903.01)**

Rejection of claims in patent application under 35 U.S.C. §103(a) must be vacated and remanded, since patent examiner has cited numerous references in support of rejection, but has not indicated what that prior art would have meant to person of ordinary skill in art, since examiner has not referred to specific portions of each of cited references, and since rejection therefore requires both applicants and Board of Patent Appeals and Interferences to speculate as to portions of each reference relied upon, and why those references would contain teaching, suggestion, motivation, or incentive leading to claimed invention; in entering any new rejection, examiner should adopt practice described in Manual of Patent Examining Procedure for setting forth Section 103(a) rejection in office action, and should reproduce rejected claim or claims with reference therein to column and line of each relevant prior art reference.

Case History and Disposition

Patent application of Robert J. Gambogi, Steven W. Fisher, Edward A. Tavss, and Marilou T. Joziak, serial no. 09/065,267.1 Applicants appeal from examiner's final rejection of claims 1-15 in application. Vacated and remanded.

[Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion

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is not binding precedent of the board.]

Judge:

Before Winters and William F. Smith, administrative patent judges, and McKelvey, senior administrative patent judge.

Footnotes

1 Application for patent filed 23 April 1998. The real party in interest is Colgate-Palmolive Co. (Appeal Brief, page 2).

Opinion Text**Opinion By:**

McKelvey, S.J.

*Decision on appeal under
35 U.S.C. §134*

[Unpublished] The appeal is from a decision of a primary examiner rejecting claims 1-15. We *vacate* and *remand* for further proceedings not inconsistent with the views expressed in this opinion.

A. Findings of fact

[Unpublished] The record supports the following findings by at least a preponderance of the evidence.²

The invention

[Unpublished] 1. The claimed invention relates to (1) a two-component dental composition

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and (2) a method of using the composition.

The examiner's rejections

[Unpublished] 2. According to the Examiner's Answer (Paper 11,3 page 4), the rejection is set out in the Final Rejection (Paper 4).

[Unpublished] 3. The final rejection makes the following rejections (page 3):

[Unpublished] Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al. (I-II-III) or Fisher et al. U.S. 5,780,015 (details noted above) taken with any one of each of: Toy, newly cited, Fischer, Collins et al., or Norfleet et al. (I-VI) * * *.

[Unpublished] 4. The rejection, stated in different terms, is as follows:

[Unpublished] Claims 1-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over the following prior art references, each of which is a U.S. patent:

- [Unpublished] (1) Campbell I,
- [Unpublished] (2) Campbell II,
- [Unpublished] (3) Campbell III or
- [Unpublished] (4) Fisher 4

[Unpublished] taken with any one of:

- [Unpublished] (a) Toy,
- [Unpublished] (b) Fischer,
- [Unpublished] (c) Collins,
- [Unpublished] (d) Norfleet I,
- [Unpublished] (e) Norfleet II,
- [Unpublished] (f) Norfleet III,

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- [Unpublished] (g) Norfleet IV,
- [Unpublished] (h) Norfleet V or

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[Unpublished] (i) Norfleet VI.

[Unpublished] 5. A person with rudimentary skills in mathematics will immediately appreciate the fact that the examiner has entered no less than 36 separate rejections (i.e., 4 times 9 equals 36).

[Unpublished] 6. According to the final rejection (page 4), each of the Norfleet patents is said to describe a hydroxide with a pH of 6 to 8, preferably 7. No reference is made to a column and/or line of any of the Norfleet patents.

[Unpublished] 7. Further according to the final rejection (page 4), Collins is said to describe the hydroxide and a pH of 6 to 8. No reference is made to a column and/or line of Collins.

[Unpublished] 8. Still further according to the final rejection (page 4), "especially" Fischer describes two other hydroxides and a pH of 4 to 9, preferably 5 to 7. No reference is made to a column and/or line of Fischer.

[Unpublished] 9. Certain compositions are said to be described by each of the three Campbell patents and Fisher.

[Unpublished] 10. There follows a reference to page 4, lines 1-7 of some document. The reference may be to page 4, lines 1-6 of applicants' specification.

[Unpublished] 11. Claim 1 contains limitations reading a "component containing" two ingredients and a "component containing" one ingredient.

[Unpublished] 12. The examiner asserts, without any underlying analysis, that "containing" is "open-ended", i.e., means "comprising." Ultimately, the examiner suggests that "containing" should be replaced with "consisting essentially of".

[Unpublished] 13. The examiner's final rejection is basically uninformative, if not unintelligible.

The appeal brief

[Unpublished] 14. Notwithstanding the vague nature of the final rejection, applicants make a

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reasonable attempt in the Appeal Brief (Paper 10) to explain why the final rejection is wrong.

[Unpublished] 15. Not without reason, applicants interpret the examiner's suggestion to replace "containing" with "consisting essentially of" as some form of rejection under 35 U.S.C. §112, second paragraph. Ultimately, in the Examiner's Answer (Paper 11, page 9), the examiner attempts to make clear that no §112 rejection was made.

[Unpublished] 16. With commendable patience, applicants attempt to address the examiner's rejections—rejections which basically cannot be addressed because they are so vague.

Examiner's answer

[Unpublished] 17. The Examiner's Answer (Paper 11) does little to clarify the examiner's otherwise vague rejections.

[Unpublished] 18. At one point in the Examiner's Answer (Paper 11, page 3), the examiner asserts that "the appealed claims clearly encompasses prior art * * * patents * * *" leaving the possible impression that one or more claims are unpatentable under 35 U.S.C. §102 for anticipation.

[Unpublished] 19. The examiner says that claims 1-15 stand or fall together (Paper 11, page 3) when applicants make perfectly clear that claims 1-7 are one group (compositions claims) and claims 8-15 are another group (process claims).

[Unpublished] 20. In the Examiner's Answer, and for the first time in the prosecution, the examiner takes what we believe the examiner thought was official notice of a fact that certain salts are not stable in certain environments (page 4), citing §2144.03 of the *Manual of Patent Examining Procedure*.

[Unpublished] 21. The examiner goes on to state, without citation to the page and line of any document, that applicants admit certain facts.

[Unpublished] 22. According to the examiner, one of the prior art references "admittedly discloses" certain facts, although absolutely no reference is made to a column and/or line of the

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reference or where the applicants are said to have made any admission.

[Unpublished] 23. Nothing in the Examiner's Answer clarifies in any material way the vague rejections made in the final rejection.

[Unpublished] 24. Interestingly enough, applicants filed no reply brief, and with good reason. We find no fault with applicants having declined to file a reply brief. We would have found it difficult, given the prosecution, to respond to the Examiner's Answer.

B. Discussion

1.

[Unpublished] The board in an ex parte appeal is basically a board of review---we review final rejections made by patent examiners. In order to have

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meaningful review, we must be able to understand the examiner's rejection, or in this case the examiner's 36 rejections. This appeal reminds us of *In re Herrick*, 344 F.2d 713, 145 USPQ 400 (CCPA 1965). There the CCPA said (*id.* at 716, 145 USPQ at 400):

[Unpublished] We have begun our consideration of the rejections in this case with a purely numerical analysis, and we have ended it there, for, as will become apparent, the existing situation does not permit rational isolation and determination of the legal issues which may be present.

[Unpublished] The CCPA went on to state (*id.* at 716, 145 USPQ at 401):

[Unpublished] The form of the rejection would seem to indicate that many of the references were considered merely cumulative. And yet, the examiner's answer * * * describe[s] and analyze[s] each reference in some detail.[5] Such a state of affairs places this court in a very real quandary. Are we to choose one individual rejection for each claim and turn the entire appeal on the correctness of those rejections? Or are we to work our way step-by-step through

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each rejection in the hope of finding one we can sustain? Neither alternative is satisfactory from the standpoint of the public interest.

[Unpublished] * * *

[Unpublished] We decline to substitute speculation as to the rejection for the greater certainty which should come from the Patent Office in a more definite statement of the grounds of rejections. To the extent that the references are *truly* cumulative, the examiner or board can so indicate. If, on the other hand, all or most of the references are really necessary to meet the claims, the rejection can be made specific as to particular references.

[Unpublished] What the CCPA said in *Herrick* applies to this case.

[Unpublished]

[1] There may be times when the use of numerous references can be justified. *Cf. In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) (the criterion is not the number of references, but what they would have meant to a person of ordinary skill in the art). In this case, however, the examiner has not told applicants or the board what the prior art would have meant to a person skilled in the art. Moreover, the examiner has not referred to specific portions of each of the references. *Cf. In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981), which the Federal Circuit in *In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), characterized as holding that when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art). Thus, both applicants and the board have to speculate as to the portions of each reference relied upon and why those references would contain a teaching, suggestion, reason, motivation or incentive leading to the claimed invention.

[Unpublished] We decline to tell an examiner precisely how to set out a rejection. We recommend that in entering any new rejection in the application on appeal that the examiner adopt the practice set out in §706.02(j) of the *Manual of Patent Examining Procedure* which contains a discussion of what an examiner should set forth in an Office action when making a rejection under 35 U.S.C. §103(a). Moreover, we additionally recommend that the examiner use the practice set out in *Ex parte Braeken*, 54 USPQ2d 1110, 1112-1113 (Bd. Pat. App. & Int. 1999), i.e., reproducing the claim with reference therein to the column and line of a relevant prior art

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reference.

2.

[Unpublished] There are numerous other difficulties with the appeal.

a.

[Unpublished] We find it somewhat curious that the examiner found it necessary to cite and rely on Toy in the final rejection, while at the same time continuing to rely on numerous other possibly cumulative references. On the one hand, Toy is said to be necessary in view of amendments made by applicants (Paper 4, page 4). On the other hand, the examiner continues to alternatively rely on Fischer, Collins or any one of the six Norfleet patents. If Toy contains disclosure not contained by Fischer, Collins or the six Norfleet patents and Toy is necessary to meet the claims as amended, then why would it be necessary to continue to rely on Fischer, Collins and the six Norfleet patents.

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b.

[Unpublished] We also find that the examiner appears to have taken official notice of certain facts in the first instance in the Examiner's Answer. Taking official notice of facts for the first time in an Examiner's Answer would not appear to be consistent with the complete examination required by 37 CFR §1.104. If the facts officially noticed are necessary, the time for taking official notice is in the first action when an applicant has a meaningful opportunity to challenge the correctness of the fact officially noted.

c.

[Unpublished] The examiner has alleged that applicants have admitted certain facts. When an examiner alleges that an applicant has admitted certain facts, the examiner is manifestly under

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a burden of citing the precise page and line of the document in which the admission occurred. Otherwise, the applicant will have difficulty addressing any issue of whether an admission has been made.

[Unpublished] We recognize that in this case the examiner could say that applicants had an opportunity in a reply brief to challenge the correctness of the fact officially noted and the facts said to have been admitted. While it is true that applicants did not file a reply brief in this appeal, it is also true that the examiner's rejection is so vague that filing of a reply brief might well have been considered a futile act on the part of the applicants. Nothing in the Examiner's Answer materially clarified the vague final rejection. Hence, the absence of a reply brief is no basis upon which to penalize applicants in this particular case. It is not an applicant's responsibility to set out a clear and concise rejection in their reply brief—setting out a rejection is the responsibility of the examiner.

d.

[Unpublished] In the final rejection, the examiner held that "containing" is an open-ended "transitional" phrase having the same meaning as "comprising" (Paper 4, page 3). The issue of whether "containing" is open-ended, like "comprising," or means something else, like "consisting essentially of" or "consisting", is a matter which should be evaluated on a case-by-case basis. Cf. the discussion under OTHER TRANSITIONAL PHRASES in § 2111.03 of the *Manual of Patent Examining Procedure* (discussing prior court interpretations of "having" and "composed of"). See also *Crystal Semiconductor Corp. v. Tritech Microelectronics International, Inc.*, 246 F.3d 1336, 1348 (Fed. Cir. 2001) ("having" does not create a presumption that the body of the claim is open; rather the claim must be examined in its full context to determine whether "having" limits the claims to its recited elements); *AFG Industries, Inc. v. Cardinal IG Co., Inc.*, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780 (Fed. Cir. 2001) ("composed of" in this case was interpreted to be the same as "consisting essentially of").

C. Order

[Unpublished] Upon consideration of the appeal, and for the reasons given, it is

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[Unpublished] ORDERED that the examiner's rejection of claims 1-15 over the prior art as set out in the final rejection is *vacated*.⁶

[Unpublished] FURTHER ORDERED that the application is *remanded* to the examiner for action not inconsistent with the views expressed in this opinion.

[Unpublished] FURTHER ORDERED that nothing in this opinion should be read as precluding the examiner from entering a new rejection.

[Unpublished] FURTHER ORDERED that we express no views on the ultimate merits of any rejection under 35 U.S.C. §103(a) based on the prior art references or any additional prior art which the examiner and applicant may wish to make of record.

[Unpublished] FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR §1.136(a).

VACATED and REMANDED

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Footnotes

2 To the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

3 The "contents" of the file wrapper of the application on appeal identify the Examiner's Answer as Paper 11. The Examiner's Answer, on the other hand, bears "Paper No. 10". According to the "contents," the Appeal Brief is Paper 10.

4 The reader should be aware that the examiner has relied on a "Fischer" and a "Fisher" reference

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which are different references.

5 In the appeal before us, apparently unlike the appeal in *Herrick*, the examiner has *not* analyzed each reference in any meaningful detail.

6 The effect of a decision vacating an examiner's rejection is explained in *In re Zambrano*, 58 USPQ2d 1312 (Bd. Pat. App. & Int. 2001) (noting that vacated rejection no longer exists).

**- End of Case -
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